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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,747	11/28/2001	Hiroyuki Kurase	0879-0364P	8657

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EXAMINER
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AGGARWAL, YOGESH K

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/994,747

Applicant(s)

KURASE, HIROYUKI

Examiner

Yogesh K. Aggarwal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4 and 9-15 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4 and 9-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

1. Newly submitted claims 14 and 15 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons. Newly-added dependent claims 14 and 15 recite features of Species II and III respectively and only specie I was elected without traverse.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 14 and 15 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Response to Arguments***

2. Applicant's arguments with respect to claims 4, 9-13 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4, 9, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ejima et al. (US PG-PUB # 2002/0027602) in view of Habuto et al. (US Patent # 6,810,441).

[Claim 4]

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Ejima et al. teaches a camera (figure 6) with audio reproduction function (Paragraph 60), comprising an image pick-up device (20) which converts an optical image into an electrical signal (Paragraph 54); an image-capturing instructing device (figure 1, element 10) which instructs the start of a picture taking operation with the image pick-up device (Paragraph 44), a signal processing device (31) which processes the electrical signal obtained by the image pick-up device to convert it into the image data (Paragraph 55), a recording device (24) which records the image data obtained by the signal processing device on a recording medium (Paragraph 56), a reproduction processing device (39) which reproduces an audio file recorded on the recording medium (Paragraph 60), an audio output device (5) which outputs the audio reproduced by the reproduction processing device audibly (Paragraph 116), an instruction input device (7) which instructs whether the deletion of audio file is permitted or not (Paragraphs 131-133).

Ejima et al. teaches a method of deleting an audio file (represented by the sound icon 63 in figure 10) employing an apparatus (figure 6) having a function of reproducing the audio file to be output as audio (Paragraphs 115-116), comprising reproducing the audio file selected as a deletion object to allow an operator to confirm whether or not a deletion object is correct (Paragraphs 131-133, 140-142, figures 10, 11, 13) but fails to teach a device which detects an empty capacity of the recording medium and determines an estimated recording data amount of image acquired by an image-capturing operation using the image pick-up device and a control device which controls selective deleting of an audio file from said recording medium, wherein when the empty capacity of the recording medium is less than the estimated recording amount; said control device controls selective deleting by controlling the deleting of the candidate

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deletion object upon determining that an operator is proceeding with a previously-initiated picture taking operation.

However Habuto et al. teaches a MPU 19 (col. 9 lines 64-64, figure 4), which detects an empty capacity of the recording medium and determines an estimated recording data amount of image acquired by an image-capturing operation using the image pick-up device (col. 12 lines 9-29). Habuto et al. further teaches selective deleting of an audio file from said recording medium 30 when the empty capacity is less than the estimated recording data amount (col. 12 line 30-col. 13 line 19, figure 8) in order to increase the recording capacity by erasing unnecessary data belonging to audio or voice category. Habuto also teaches that not only all audio (non-conforming) files can be deleted but also any one of the audio or voice file can be deleted by displaying the size of the file to be erased (col. 9 lines 11-21). Examiner is reading a picture taking operation as two-step processes namely start of an image capture and then saving the image in a recording medium. In Habuto, when the user tries to capture an image of the subject, the digital still camera 10 displays under the control of the MPU 19 displays, on the display unit 18, a message such as "no more images can be captured" as shown in the display screen D2 (col. 12 lines 20-24). Therefore the first step of a picture taking operation process namely start of an image capture is taking place. Thus the newly added limitation of 'deleting the audio file upon determining that an operator is proceeding with a previously-initiated picture taking operation' is being read. ['proceeding with a previously-initiated picture taking operation' is a very broad term which includes start of an image capture operation which cannot be completed because the image cannot be saved as the recording medium is full as taught in the reference].

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Therefore taking the combined teachings of Ejima and Habuto, it would have been obvious to one skilled in the art at the time of the invention to have been motivated to have a device which detects an empty capacity of the recording medium; a device which grasps an estimated recording data amount of image acquired by an image-capturing operation using the image pick-up device and controls selective deleting of an audio file from said recording medium wherein when the empty capacity of the recording medium is less than the estimated recording amount, said control device controls selective deleting by controlling said deletes the candidate deletion object upon determining that an operator is proceeding with a previously-initiated picture taking operation in order to increase the recording capacity for taking the image by erasing unnecessary data belonging to audio or voice category as taught in Habuto (col. 13 lines 17-19).

[Claims 9 and 10]

Habuto teaches that after the display unit 18 displays a message such as “no more images can be captured” on the display screen D2 (col. 12 lines 20-24), only the first step of a picture taking operation namely start of an image capture as defined in claim 4 has taken place. Therefore a previously initiated picture taking operation is not completed or in other words it has stopped half way [as defined above]. Habuto further teaches that the user can choose different categories e.g. “erase data in another category” which has audio and voice files (D5 and D6) that the user can deselect by saying “no” (col. 12 lines 30-67) and therefore prevents deletion of a candidate deletion object or select any different file for deletion.

[Claim 13]

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Habuto teaches that the image cannot be captured (captured or saved) because the memory is full, so an audio file is deleted before capturing an image.

5. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ejima et al. (US PG-PUB # 2002/0027602), Habuto et al. (US Patent # 6,810,441) and further in view of Yamaoka (US Patent # 5,130,812).

[Claims 11 and 12]

Ejima in view of Habuto fails to teach wherein said image-capturing instructing device is a shutter button, and the operator fully depresses the shutter button to indicate that the candidate deletion object should be deleted or when it is released the shutter button to indicate that the candidate deletion object should not be deleted.

However Yamaoka teaches that when a shutter button is half depressed, an audio file is erased so that if a user does not like a particular file a new audio file can be recorded (col. 19 lines 31-42). It would be obvious to one skilled in the art to have the shutter fully depressed instead of being half depressed as they are obvious variations. It is also noted that if the shutter is not depressed or released the audio file would not be deleted.

Therefore taking the combined teachings of Ejima, Habuto and Yamaoka, it would have been obvious to one skilled in the art at the time of the invention to have been motivated to have an image-capturing instructing device with a shutter button so that when the operator fully depresses the shutter button to indicate that the candidate deletion object should be deleted or when it is released the shutter button to indicate that the candidate deletion object should not be deleted so that if a user does not like a particular file a new audio file can be recorded by deleting the previous file.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh K. Aggarwal whose telephone number is (571) 272-7360. The examiner can normally be reached on M-F 9:00AM-5:30PM.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571)-272-7593. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.




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8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YKA

August 15, 2005



DAVID L. OMETZ  
SUPERVISORY PATENT  
EXAMINER